

REMARKS

Claims 1-8 are pending in the instant application. No claims are amended or cancelled herein.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Publication No. 2003/0189912 to Laitinen et al. (hereinafter referred to as Laitinen) in view of United States Patent No. 5,701,585 to Kallin et al. (hereinafter referred to as Kallin) and United States Patent No. 5,749,055 to Dahlin (hereinafter referred to as Dahlin). Applicants respectfully traverse.

The office action relies on three separate references to allege that the recitations of independent claims 1, 5 and 8 are obvious. But even supposing that the claims can be read so broad as to be interpreted as the features taught by the relied upon portions of the cited references, the references fail to teach the very specific order of operations found in the claims.

As recited in claim 1, the very first step of the method is for the network to determine that the cell the terminal is located in is saturated. Only after this determination is system information sent to the terminal from the network in order to initiate the handoff. Subsequently the terminal performs measurements of the neighboring cells and only after performing the measurement are the measurements sent to the network. Following this sending of measurements, the procedure of handover is initiated. Finally, after receiving the first set of measurements is a second set (the first group) of system information sent to the terminal. Further at the same time as the initiation of the handover and the sending of the "first group of system information" additional measurements are taken of the neighboring cells and those measurements are separately sent to the network.

Thus, the present claims as recited in independent claims 1, 5 and 8 require a very specific order of operations and could not simply be arrived at by the combination of the relied upon portions of the cited references. Accordingly, claims 1, 5, and 8 patentably distinguish over the relied upon portions of the cited references and are allowable. Claims 2-4 and 2-7 which depend from one of these base claims are allowable therewith.

The office action invokes the holding in the recent decision in *KSR Int'l Co. v. Teleflex Inc.*, No 04-1350 (U.S. Apr. 30, 2007). In view of the recent USPTO memorandum dated May 3, 2007, discussing the *KSR* case, it is submitted that the office action does not provide sufficient explicit analysis as to whether there was an apparent reason to combine the references as suggested. *Memo* at 2. Such an explicit analysis should include a detailed statement outlining the “effects of demands known to the design community or present in the marketplace,” and “the background knowledge possessed by a person having ordinary skill in the art.” *KSR* at 14. The Examiner is reminded that nothing in *KSR* eliminated the obligation of the USPTO to refrain from using improper hindsight in combining references to formulate a rejection under § 103. *KSR* at 17.

Claims 1, 5, and 8 recite specific order of steps that is not found in the relied upon portions of the cited references. The office action does not include a statement regarding the demands of the marketplace or design community. Nor is there a statement regarding the knowledge of one of ordinary skill in the art. Still further, it is submitted that the instant claimed invention is not one in which there are a “finite number of identified, predictable solutions a person has good reason to pursue.” *KSR* at 13.

Accordingly, it is submitted that the combination of references as recited in the office action, in addition to failing to teach each and every element of the claims and the specific order

of operations, fails to meet the requirements of *KSR*. Accordingly, withdrawal of the rejection under 35 U.S.C. § 103(a) is requested.

CONCLUSION

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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